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09/474,418	12/29/1999	RONALD G. KENNEDY	GEM-30834	2216

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EXAMINER

GEREZGIHER, YEMANE M

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/474,418
Filing Date: December 29, 1999
Appellant(s): KENNEDY, RONALD G.

Timothy J. Ziolkowski
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 03/13/2006 appealing from the
Office action mailed 10/06/2005.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon:

5,938,607	Jago et al.	8-1999
5,715,823	Wood et al.	4-1999
5,786,994	Friz et al.	7-1998

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jago et al., U.S. Patent No. 5,938,607 in view of Wood et al., U.S. Patent No. 5,715,823.

Claims 1-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jago et al., U.S. Patent No. 5,938,607 in view of Friz et al., U.S. Patent No. 5,786,994.

Claims 1-24 are rejected under the judicially created doctrine of double patenting over claims 1-44 of U.S. Application SN: 09/199,506.

(10) Response to Argument

a. In regard to the rejection under 35 U.S.C. 103(a), Appellant asserts that there is insufficient motivation and/or suggestion to combine the already combined teachings of Wood and Jago and Friz and Jago; and that the examiner's reasoning/motivation is based on impermissible hindsight derived from the Appellant disclosure in concluding the obviousness analysis and further alleges that Friz is not analogous art to combine with the invention of Jago (See Appeal Brief, Page 5, Last 3 lines of ¶1, Page 6, ¶1, Page 6, first 4 lines of ¶3 and Page 14, Lines ¶2).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In this case, among various possible motivations, it is apparent to one of ordinary skill in the art at the time of the invention that both

concepts of the claimed invention and the applied prior art of record do share at-least one common interest and/or motivation; where the motivation is to enable image scanning devices such as ultrasound scanning apparatuses to be connected to a centralized system/server in a communication network, so that users including doctors and other health professionals to share information related to scanned images of patients in an interconnected network (see Wood, Column 1, Line 14 through Column 2, Line 19 and see Appellant's Spec., Page 2, Line 5 through Page 3, Line 14). Thus, appellant's argument directed to the concern of motivation to combine is not valued.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). Since the concept of the applied prior art and the concept of the claimed novelty are indistinguishable, it is safe to believe that the alleged *impermissible hindsight* is not true, but could

sound alike due to the commonality of the prior art and the claimed invention.

In response to the argument directed to the question of whether Friz is analogous or not, the examiner asserts that the Friz is analogous with the teachings of Jago, because both are directed to a communication network interconnecting image scanning devices for sharing information over the network.

As evidenced by the appellant affirmation, “Jago et al. teaches the remote access to the images of the medical imaging device, Friz et al. teaches a method of networking a plurality of printing devices connected to the medical imaging system. Unlike the presently claimed invention, Friz et al. is directed to a system that is connectable therewith...” (See Appellant, Appeal Brief, Page 14, last 4 lines of ¶3). Assuming arguendo that the appellant is correct and the contention made is proper (Friz been “readily connectable” V.S. claimed limitation directed to “not readily connectable...”). The simple fact, which the claimed limitation is been “not readily connectable...” and the fact that the teaching of Friz is been already readily connectable does not eliminate the fact that the already combined teachings from being analogous to one another.

Friz disclosed remote monitoring of remotely located laser imagers (see Friz, Abstract and Column 3, Lines 16-65). The fact that both are teachings about image scanning apparatus readily

connectable/connected to a central management site, they are reasonably conceded to be analogous to one another.

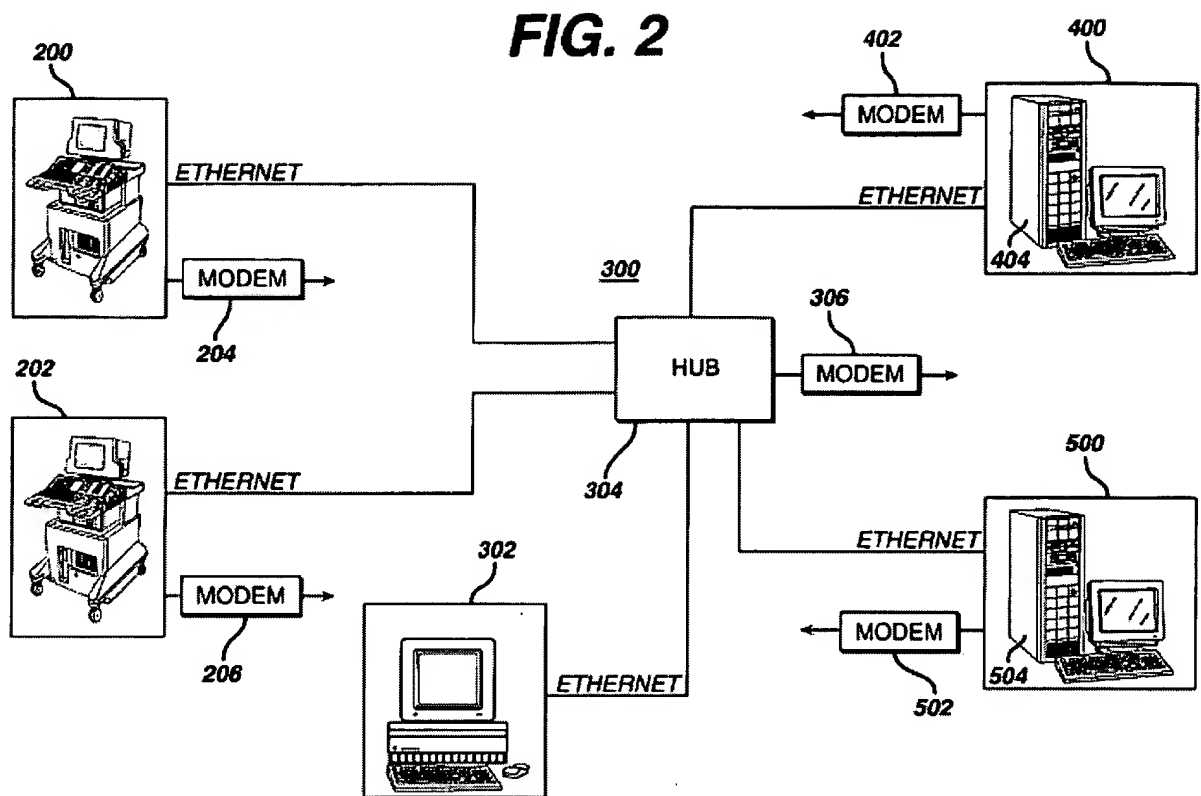
b. The appellant asserts that the applied prior art of record teaches away from the claimed invention “because they (Wood and Jago) are **already capable of direct communication**” (See Appeal Brief, Page 7, ¶¶2-3 and Page 11, last 6 lines of ¶2) and that the already combined teachings of Wood and Jago failed to teach an in-field product that is **not** readily capable of direct connection and establishing a connection between the in-field product and the remote online center through portable service interface (See Appeal Brief, Page 12, ¶3 and Page 13, ¶¶1-2). Further, See Appellant, Appeal Brief, Page 18, ¶2 (argument directed to “...*Jago and Friz are readily capable of direct communication with an online center*” **V.S.** *claimed limitation of not readily capable of connecting and connecting the not readily capable of connecting devices via a portable service interface to connect the in-field product and the online central site/server.*

The examiner respectfully disagrees with these contentions because:

...“the prior art’s mere disclosure of more than one alternative does not constitute a teaching away from any of these alternatives because such

disclosure doesnot criticize, discredit, or otherwise discourage the solution claimed....” In re Fulton, 391 F.3d 1195, 1201, 73 USPQ2d 1141, 1146 (Fed. Cir. 2004).

In similarity with the claimed invention, the prior art of record shows (For example see Fig. 2 attached below) medical devices readily capable of direct connection with the network for transmitting and receiving information including images from one apparatus to another via a “central site/server such as the hospital information system”, Jago, Column 8, Lines 64-66. Furthermore, the examiner note that the teachings of Jago is not “teachings a way”, but simply showing a step ahead feature that facilitates the connectivity of these image scanning devices. In this case the teachings of Jago/Wood is not teaching a way, but teaching one positive step further. Thus, the allegation made is not credible. Furthermore, it has to be recognized that at the time the invention was made, devices let alone medical scanning devices, but including many computers did not come with built-in connection capability by design or automatically. Having that said, connectable features such as modems and Ethernet connectivity were not a standard, but add-ons, which implies that that the scanning (ultrasound) systems disclosed in Fig. 2 below were devices **“not readily capable of direct connection”** as recited by the inventive entity.



c. The appellant argue that “Combining the references does not result in an in-field product at a customer site that **is not readily capable of direct communication** with an on-line center and at least one portable service interface operable with the in-field product at the customer site and having software for communication with the on-line center as called for in the present claims. The combination of Jago et al. and Wood et al. would simply result in an in-field device that has a redundant communication link with the remote system, each of which is a direct

link. To conclude otherwise is contrary to the express disclosure of the references.” (See Appeal Brief, Page 8, ¶2). Further, the appellant recite, “As both Jago et al. and Wood et al. disclose an ultrasound system which includes a server which “makes the system's images and reports accessible to a personal computer, terminal, or workstation at a remote location”, the systems disclosed in Wood et al. and Jago et al. **are systems readily capable of direct communication with an on-line center and are not systems which are not readily capable of direct communication** with an on-line center as called for in claim 1” (See Appeal Brief, Page 9, ¶3).

In response to applicant's argument that “the combination of Jago et al. and Wood et al. would simply result in an in-field device that has a redundant communication link with the remote system”, the examiner point the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

In this case, even though it is not necessary true that the “combination of Jago et al. and Wood et al. would simply result in an in-field device that has a redundant communication link with the remote

system, each of which is a direct link”, there is nothing wrong with achieving such additional advantage by combining the teachings.

The appellant continues with experimental analysis in generating possible outcomes or end-results of the combined teachings (Jago & Friz) that is different than the expected outcome of the claimed invention. For example, see Appeal Brief on Page 15, which read as:

Combining the system of Friz et al. with Jago et al. results in a system wherein the imaging system of Jago et al. is connected to a laser medical imager system of Friz et al. The system of Friz et al. does not service, update, or communicate other than to receive data from the imaging system of Jago et al. Any motivation to combine the systems of Jago et al. and Friz et al. adds nothing to the respective systems disclosed therein. Appeal Brief, Page 15, last 5 lines of ¶1.

Nevertheless, the examiner points that another benefit when combining the prior art of record as noted by the appellant does not negate the combined teachings for purposes of avoiding the prior art as it is already properly applied to the claims as recited in the last office action.

d. The appellant contend that none of the prior art of record as applied teaches, suggests interfacing between the online center and the in-field

product with the portable service interface as recited in claim 10 (See Appeal Brief, Page 12, ¶2)

The examiner respectfully disagrees with the appellant's allegation. Jago/Wood disclosed a portable interfacing device #304 connected to the image scanning devices via Ethernet line and the portable interfacing device, the portable interfacing device further connected to a central site through the connection capability of the portable interfacing device # 306 having therein modulation/de-modulation module (see Fig. 2, also disclosed above, Jago, Column 8, Lines 35-67 and Column 9, Lines 49-67).

- e. In response to the Appellant's statement on the
- f. In response to the Provisional double patenting rejection of claims 1-24 under the judicially created doctrine of double patenting over claims 1-44 of Application No. 09/199,506. The appellant responds by reciting the following citation:

MPEP §804(I)(B) states that "[i]f the provisional' double patenting rejection in one application is the only rejection remaining in that application, the examiner should then withdraw that rejection and permit the application to issue as a patent." Since no sustainable basis of rejection is believed to exist, and U.S. Ser. No. 09/199,506 has not issued as a patent, Appellant requests withdrawal of the provisional

double patenting rejection and a timely issuance of a Notice of Allowance for claims 1-24.

The examiner note that the cited § of the MPEP [MPEP §804 (B)(1)], which states as follows:

1. > Nonstatutory Double Patenting Rejections

If a “provisional” nonstatutory obviousness-type double patenting (ODP) rejection is the only rejection remaining in the earlier filed of the two pending applications, **while the later- filed application is rejectable on other grounds**, the examiner should withdraw that rejection and permit the earlier-filed application to issue as a patent without a terminal disclaimer. If the ODP rejection is the only rejection remaining in the later-filed application, while the earlier-filed application is rejectable on other grounds, **a terminal disclaimer must be required in the later-filed application before the rejection can be withdrawn.**

Thus, since this application is a later-filed application having therein an art rejection applied in addition to the pending double patenting rejection, appellant’s response is not persuasive to overcome the pending rejection the judicially created doctrine of double patenting over claims 1-44 of Application No. 09/199,506.

For the above reasons, it is believed that the rejections should be sustained.

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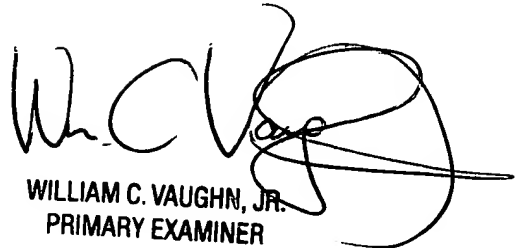
Respectfully submitted,

YMG

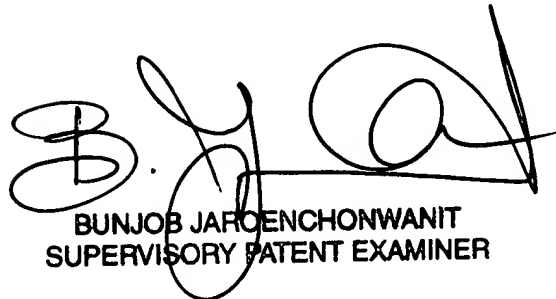
May 3, 2006

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